Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
YOR920030480US1

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	10/723,344	November 26, 2003
on _____	First Named Inventor	
Signature_____	C.A. Lang	
	Art Unit	Examiner
Typed or printed name _____	2178	Gregory J. Vaughn

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
  (Form PTO/SB/96)

☑ attorney or agent of record. Registration number 39,274

☐ attorney or agent acting under 37 CFR 1.34.

  Registration number if acting under 37 CFR 1.34 _____

_____ Signature
William E. Lewis
Typed or printed name

516-759-2946
Telephone number

June 29, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐   *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): C.A. Lang et al.
Docket No.: YOR920030480US1
Serial No.: 10/723,344
Filing Date: November 26, 2003
Group: 2178
Examiner: Gregory J. Vaughn

Title: Methods and Apparatus for Knowledge
Base Assisted Annotation

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection, dated April 29, 2009, in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is submitted concurrently herewith.

The present application was filed on November 26, 2003 with claims 1-18. In a previous response, claims 5 and 15 were canceled. Claim 19 has been added. Claims 1 and 16-18 are the pending independent claims. In the final Office Action dated April 29, 2009, the Examiner rejected claims 1-4, 6-11, and 16-19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,309,359 (hereinafter "Katz") in view of U.S. Patent No. 6,697,799 (hereinafter "Neal"). In addition, the Examiner rejected claims 12-14 under 35 U.S.C. § 103(a) as being unpatentable over Katz in view of Neal, and further in view of Handschuh et al., "S-CREAM – Semi-Automatic Creation of Metadata" (hereinafter "Handschuh").

With regard to the Examiner's § 103 rejection of claims 1-4, 6-11, and 16-19 in view of Katz and Neal, Applicants note that the cited references fail to teach the recited limitations. Specifically, Katz and Neal fail to teach the limitations of independent claims 1 and 16-18.

Claim 1 recites a method of determining an annotation for a document, the method comprising the steps of: obtaining an annotation proposed by a user to be associated with the document; automatically determining, in accordance with a knowledge base containing allowed

annotations, whether the user-proposed annotation matches one or more allowed annotations from the knowledge base; and annotating the document with an allowed annotation from the knowledge base when the user-proposed annotation matches the allowed annotation from the knowledge base; wherein the user need not consider any annotations when a single allowed annotation is automatically determined to match the user-proposed annotation, and when more than a single annotation is automatically determined to match the user-proposed annotation: (a) in a first mode, the user need only consider the matching allowed annotations and select one of the matching allowed annotations; and (b) in a second mode, the user need not consider any annotations but rather one of the allowed annotations is automatically selected.

The Examiner argues at p. 2, sec.6 of the final Office Action that Katz teaches the limitations of claim 1 at Katz, col. 2, ll. 42-45; col. 2, ll. 54-55; and col. 3, ll. 3-7. Applicants disagree. At col. 2, ll. 42-45, Katz recites, "The basic feature of the invention is that selected subdivisions of the text, such as sentences, paragraphs, sections, chapters, articles, columns, or the like, are annotated, preferably with natural language questions, assertions, or noun phrases." Next, Katz at col. 2, ll. 54-55 discloses that "[t]he annotations may be generated manually, semiautomatically or automatically." Further, Katz at col. 3, ll. 3-12 recites, "In another method for the semiautomatic generation of annotations, a database of annotation groups is formed from existing annotated subdivisions. One annotation for a current text is then selected, either by an operator or by some automatic technique, and the database of annotations is then searched for a similar annotation. Other annotations in the annotation group containing a similar annotation to the selected one are then either used or proposed to annotate the current text subdivision." Applicants respectfully submit that the cited portions of Katz do not teach the recited steps of: obtaining an annotation proposed by a user to be associated with the document; automatically determining, in accordance with a knowledge base containing allowed annotations, whether the user-proposed annotation matches one or more allowed annotations from the knowledge base; and annotating the document with an allowed annotation from the knowledge base when the user-proposed annotation matches the allowed annotation from the knowledge base.

First, the cited portions of Katz do not teach obtaining an annotation proposed by a user to be associated with the document. Katz discloses that "a database of annotation groups is formed from existing annotated subdivisions." Katz, col. 3, ll. 3-12. Further, Katz discloses that "[o]ne annotation for a current text is then selected, either by an operator or by some automatic technique, and the database of annotations is then searched for a similar annotation." Id. Applicants note that

an annotation selected for current text is not the same as an annotation proposed by a user to be associated with the document as recited in the claims and supported in the specification. See Specification, p. 5, ll. 7-22. Selecting an annotation implies that a given annotation is selected from predefined annotations. For example, it appears that Katz discloses a database of annotations in which an annotation is selected. This is different than a user proposing an annotation. Therefore, Katz does not teach obtaining an annotation proposed by a user to be associated with the document.

It follows that Katz does not teach "automatically determining, in accordance with a knowledge base containing allowed annotations, whether the user-proposed annotation matches one or more allowed annotations from the knowledge base" as recited in the claims. Applicants assert that Katz does not teach a knowledge base containing allowed annotations. The concept of allowed annotations may be found in the specification at, for example, p. 1, ll. 9-14 ("Numerous applications require the annotation of documents with a fixed set of terms."). It should be noted that Katz simply proposes annotations for selected text. Further, Katz discloses how to quickly locate all text related to a given annotation. See Katz, col. 3, ll. 13-16 ("One or more pointers may be stored with each stored annotation so that, during a search, when an annotation is located, all text relevant to that annotation may be quickly located."). This mechanism does not teach automatically determining whether the user-proposed annotation matches one or more allowed annotations from the knowledge base. It follows that Katz fails to disclose annotating the document with an allowed annotation from the knowledge base when the user-proposed annotation matches the allowed annotation from the knowledge base as recited in the claims.

The final Office Action appears to rely on the same rationale as relied upon in the non-final Office Action dated November 13, 2008.

Furthermore, in the final Office Action, the Examiner concedes that Katz fails to describe a first mode and a second mode as claimed. Final Office Action, p. 3, first full paragraph. However, the Examiner argues that Neal remedies the deficiencies of Katz. Specifically, the Examiner implies that Neal at col. 11, ll. 48-56 teaches "wherein the user need not consider any annotations when a single allowed annotation is automatically determined to match the user-proposed annotation, and when more than a single annotation is automatically determined to match the user-proposed annotation: (a) in a first mode, the user need only consider the matching allowed annotations and select one of the matching allowed annotations; and (b) in a second mode, the user need not consider any annotations but rather one of the allowed annotations is automatically selected" as recited in the independent claims.

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Neal is silent to the annotation modes recited in the independent claims. Neal at col. 11, ll. 48-56 discloses (emphasis added):

> The determination as to whether or not to automatically classify an item can be made using thresholds. The thresholds can be made configurable by a system manager depending upon the need for accuracy as balanced against the amount of operator interaction desired. In this approach, the confidence score at each search view is compare to a configurable threshold. <u>If the score is above the threshold, then it is automatically classified. If it is below the threshold, then it is submitted to a user for human review and selection.</u>

Automatically classifying an item when the confidence score is above the configurable threshold does not teach the recited limitations. Further, submitting to a user for human review and selection when the confidence score is below the configurable threshold does not teach the recited limitations. Applicants note that the claims recite specific limitations that are not evident in view of Neal's disclosure of thresholds. For instance, Neal's threshold technique does not teach that the user need not consider any annotations when a single allowed annotation is automatically determined to match the user-proposed annotation. Nor does Neal's threshold technique teach that when more than a single annotation is automatically determined to match the user-proposed annotation: (a) in a first mode, the user need only consider the matching allowed annotations and select one of the matching allowed annotations; and (b) in a second mode, the user need not consider any annotations but rather one of the allowed annotations is automatically selected. For at least these reasons, Katz and Neal fail to teach the limitations of independent claim 1.

In addition to the above, Applicants further assert that the Examiner has failed to establish a *prima facie* case of obviousness. In response to the Examiner's statement of obviousness at p. 4, first full paragraph of the final Office Action, Applicants respectfully submit that these are conclusory statements of the sort rejected by both the Federal Circuit and the U.S. Supreme Court. See KSR v. Teleflex, 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (U.S., April 30, 2007), quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."). In contrast to the Examiner's argument, there has been no showing in the present § 103 rejection of objective evidence of record that one skilled in the art would combine Katz and Neal to produce the recited limitations. For example, Katz teaches techniques for generating and utilizing annotations to facilitate computer text retrieval. Further, Neal discloses automated classification of items using
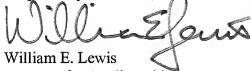
cascade searches. It would not be obvious to one of ordinary skill in the art to combine Katz and Neal to produce the recited techniques of determining an annotation for a document. Applicants further note that the Examiner is mischaracterizing Neal when he argues that Neal teaches modes, e.g., a first mode and a second mode, as recited in the claims.

The final Office Action appears to rely on the same rationale as relied upon in the non-final Office Action dated November 13, 2008.

For at least these reasons, it is believed that the combined teachings of Katz and Neal fail to meet the limitations of claim 1. Independent claims 16-18 include limitations similar to those of claim 1, and are therefore believed allowable for reasons similar to those described above with reference to claim 1. It follows that dependent claims 2-4, 6-11, and 19 are believed allowable due to their respective dependencies from independent claim 1. Handschuh fails to remedy the deficient teachings of Katz and Neal as discussed above with regard to claim 1, from which claims 12-14 depend. Further, one or more of these claims are believed to define separately patentable subject matter over the cited art.

In view of the foregoing, Applicants believe that claims 1-4, 6-14, and 16-19 are in condition for allowance and respectfully request withdrawal of the § 103 rejections.

Respectfully submitted,

Date: June 29, 2009

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